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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,729	06/23/2003	Tom Sprinkle	12873/04605	8729
24024	7590	08/09/2007		
CALFEE HALTER & GRISWOLD, LLP			EXAMINER	
800 SUPERIOR AVENUE			MITCHELL, TEENA KAY	
SUITE 1400				
CLEVELAND, OH 44114			ART UNIT	PAPER NUMBER
			3771	
			MAIL DATE	DELIVERY MODE
			08/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding:**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/601,729	Applicant(s) SPRINKLE ET AL.	
	Examiner Teena Mitchell	Art Unit 3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4, 5 and 26-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**TEENA MITCHELL**  
**PRIMARY EXAMINER**

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/5/04; 5/10/04; 5/21/05; 4/14/06</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Oath/Declaration*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application-by-application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be **material to patentability** as defined in 37 CFR 1.56.

While applicants have made a statement the statement made is improper. Applicant's state, "...which is **material to the patentability**..." the correct statement is above the use of "the" makes the statement incorrect, a new Oath/Declaration is required.

### *Election/Restrictions*

Applicant's election without traverse of Group I claims 1-5 and new claims 26-29, non-elected claims canceled 6-25 in the reply filed on 7/27/07 is acknowledged. This election is made Final.

### *Information Disclosure Statement*

The IDS dated 4/05/04 page 1, reference AI 697,762 September 30, 10953 with a filing date of March 17, 1952 has not been considered by the examiner because the date is not a correct date and there is not a named inventor, so unless the applicant can provide such information on another filed IDS the reference will not be considered as the examiner does not know what reference the applicant is making reference to.

***Claim Rejections - 35 USC § 102***

**The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**A person shall be entitled to a patent unless –**

**The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

**The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).**

**Claim 4 is rejected under 35 U.S.C. 102(e) as being anticipated by Palkon et.al. (7,007,696).**

**Palkon in a nasal mask discloses a shell (16); and a cushion (30) connected with said shell having a side wall, an inner wall extending transverse to said side wall, and**

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an outer wall extending transverse to said side wall, said outer wall being adapted to engage and seal against a face of a user of the mask (Figs. 1-11); said outer wall of said cushion extending substantially completely around said cushion (Figs. 1-11); said inner wall of said cushion being discontinuous in a nasal bridge region of said cushion of said cushion (Fig. 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palkon et.al. (7,007,696).

Regarding claim 5, Palkon discloses the claimed invention except for the specifically stating that the inner wall of the cushion is thicker and stronger than the outer wall of the cushion, however, Palkon does disclose membranes having a variable thickness that fits between the nares and the upper lip to provide superior sealing characteristics and if you look at several of the figures it appears that the inner membrane is thicker than the outer membrane, therefore based upon the variable thickness taught by Palkon and the figures it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the inner wall of the cushion to be thicker than the outer wall as such would be deemed a design consideration and providing superior sealing characteristics as taught by Palkon.

Regarding claims 26-29, note rejection of claim 5 above.

***Allowable Subject Matter***

Claims 1-3 are allowable over the prior art of record.

The following is a statement of reasons for the indication of allowable subject matter: The overall combination of the mask, shell and cushion with a retaining ring disposed in a side wall defining a gap and the cushion side wall with an outer peripheral

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edge portion including a tongue extending around the cushion wherein the tongue of the cushion is received in the gap of the shell to secure the cushion to the shell is neither anticipated nor obvious over the prior art of record.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of art is cited to show mask devices: 7,207,334; 6,701,927; 2002/0100479.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (571) 272-4798. The examiner can normally be reached on Monday-Friday however the examiner is on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Teena Mitchell  
Primary Examiner  
Art Unit 3771  
August 2, 2007

TKM  
TKM